

REMARKS

Reconsideration of the application in view of the present amendment is respectfully requested.

By the present amendment, the specification has been amended to correct a formal error therein. Claim 1 has been amended to more clearly define the present invention.

Based on the foregoing amendments and the following remarks the application is deemed to be in condition for allowance, and Action to that end is respectfully requested.

The Examiner rejected claim(s) 1-9 under 35 U.S.C. § 102(b) as being anticipated by and claims 10-11 under 35 U.S.C. § 103(a) as being unpatentable over Hornschuch, et al. U.S. Patent No. 3,608,131 (Hornschuch, hereafter Horn).

It is respectfully submitted that claims 1-11 are patentably distinct over Horn and are allowable. Firstly, Horn, which discloses a wrench for fasteners, such as a nut or the like (column 1, lines 35-36), is not a pertinent reference.

The case law holds that in order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's

endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 23 USPQ 2d 1058, 1060-61 (Fed. Cir. 1992).

Horn relates to a mechanized torque wrench and, therefore, is not in the field of the applicant's endeavor, namely, tool holders for annular core bits. Further, the object of Horn is shutting off the wrench motor in response to a selected torque load (column 1, lines 63-72), which has nothing to do with the object of the present invention, namely, to provide a tool holder for annular core bits having different (splined or thread) inner profiles.

Even assuming, *arguendo*, that Horn is pertinent reference, Horn does not disclose the claimed features of the present invention. Specifically, Horn does not disclose an end-side outer profile that extends away from a stop surface in a direction of an external part (fastener). In Horn, the splined profile (30) extends in a direction away from the stop surface (25) and away from the fastener.

Further, the splined profile (30) of Horn does not cooperate with any external part which is not part of the wrench. It cooperates with a sleeve (33)

which is part of the wrench. Clearly Horn discloses a completely different tool element.

In view of the above, it is respectfully submitted that the present invention, as defined by claim 1, is not anticipated by or is obvious over Horn, and claim 1 is patentable over Horn.

Claims 2-10 depend on claim 1 and are allowable as being dependent on an allowable subject matter.

Claim 11 relates to a tool assembly with a tool holder of claim 1 and is allowable for the same reasons claim 1 is allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,



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